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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/707,498	12/18/2003	Derek Fox	JD-195 US	1497

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EXAMINER

BISSETT, MELANIE D

ART UNIT PAPER NUMBER

1711

DATE MAILED: 07/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/707,498

Applicant(s)

FOX ET AL.

Examiner

Melanie D. Bissett

Art Unit

1711

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) 17-31 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|------------------------------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>3/04/5/05</u> . | 6) <input type="checkbox"/> Other: ____. |

3-2-0

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-16, drawn to a surface finish and method, classified in class 428, subclass 411.1.
 - II. Claims 17-20, drawn to a different surface finish, classified in class 428, subclass 318.4.
 - III. Claims 21-24, drawn to a method of finishing a surface, classified in class 427, subclass 299.
 - IV. Claims 25-27, drawn to a finished surface, classified in class 428, subclass 114.
 - V. Claims 28-31, drawn to a surface finish, classified in class 428, subclass 212.
2. The inventions are distinct, each from the other because of the following reasons:
3. Inventions I and (II or IV) are related as combination and subcombination.

Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because it does not limit the film to be perforated or to contain several film segments. The subcombination has separate utility such as a marking or protecting film.

4. Inventions III and (I or II or IV or V) are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the surface finishes can be made by pressing a flexible film to a surface without pretreatment of the base.

5. Inventions I and V are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions the inventions are different embodiments that have different effects. One has a cured coating while the other has a slip-resistant coating.

6. Inventions II and IV are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are different embodiments that have different effects. One has a perforated film while the other has plural adjacent films of the same thickness.

7. Inventions V and (II and IV) are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other

Art Unit: 1711

combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because it does not limit the film to be perforated or to contain several film segments. The subcombination has separate utility such as a marking or protecting film.

8. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

9. During a telephone conversation with Renee Rymarz on 13 July 2005 a provisional election was made without traverse to prosecute the invention of Invention I, claims 1-16. Affirmation of this election must be made by applicant in replying to this Office action. Claims 17-31 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

10. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Information Disclosure Statement

11. The application 09/867,063 has been considered but stricken from the Form PTO-1449 since it is not a published document.

Claim Rejections - 35 USC § 102

12. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

13. Claims 1, 3-4, 5-8, 10-12, 14, and 16 are rejected under 35 U.S.C. 102(b) as being anticipated by Heddon as evidenced by Suiter and *Hawley's Condensed Chemical Dictionary*. Suiter, (US 4,795,152), can be found on the applicant's Form PTO-1449.

14. Heddon discloses a surface finish for a bowling lane comprising a plastic film attached to a surface by an adhesive, where the bowling lane is finished with a hardened finishing coat and where the film is peeled from the surface for refinishing (abstract). This suggests peeling without the use of stripping agents, since none are suggested or implied. Curable coatings include urethanes and epoxies, where epoxies are known as thermosetting materials that have formed permanent crosslinking (*Hawley's Condensed Chemical Dictionary*). The reference prefers thicknesses used in previous patents, citing Suiter, who teaches film thicknesses of 3-10 mils for most of the bowling lane surface (col. 3 lines 32-37).

15. Regarding claims 3-4, it is noted that the claims are written in product-by-process format. Since the same structural characteristics would result from an ambient-cured or heat-cured epoxy coating and since the recitation of epoxy resin suggests a crosslinked

Art Unit: 1711

material, it is the examiner's position that the reference's mention of an epoxy resin coating anticipates the product-by-process claims.

16. Claims 1-2, 6-7, 9, 11, and 14 are rejected under 35 U.S.C. 102(b) as being anticipated by Helf. Helf (US 5,320,693) can be found on the applicant's Form PTO-1449.

17. Helf discloses a surface-coating composite for application to a floor comprising an adhesive, an indicia layer, and a transparent coating layer (abstract). The coating is applied after the indicia are applied to the substrate, and the coating is further dried to form an evaporatively-cured coating (col. 2 line 59-col. 3 line 5). Suitable indicia materials include sheets of the claimed film materials having a thickness of 1-3 mils (co. 4 lines 39-60). Acrylic emulsions are used as the coatings to be applied and solidified by drying (col. 6 lines 34-47).

Claim Rejections - 35 USC § 103

18. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

19. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Heddon in view of Suiter and as evidenced by *Hawley's Condensed Chemical Dictionary*.

Art Unit: 1711

20. Heddon applies as above, teaching film materials applied to bowling lanes.

However, the reference does not specify the film materials suitable in the invention.

Suiter teaches films applied to bowling lane surfaces, where polyurethanes, polyolefins, polyvinyls, and polyesters are all suitable plastic film materials having flexibility and wear resistance (col. 3 lines 44-47; col. 4 lines 15-20). Thus, it would have been prima facie obvious to use the films of Suiter's invention to provide improved wear resistance to the articles of Heddon's invention.

21. Claims 13, and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Heddon as evidenced by Suiter and *Hawley's Condensed Chemical Dictionary* and in view of Kumar et al.

22. Heddon applies as above, teaching coatings applied to a flexible film but failing to teach the cure methods of the coatings. Kumar teaches fast dry ambient temperature curable coating compositions comprising epoxy resins (abstract). The coatings may also be baked at a higher temperature to accelerate cure rate (col. 16 lines 17-42). The coatings are applied to bowling alley lanes (col. 16 line 55) and have improved solvent resistance (col. 3 lines 18-19). It is the examiner's position that it would have been prima facie obvious to bake the coatings of Heddon's invention by Kumar's teaching to accelerate the curing of the epoxy coatings.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melanie D. Bissett whose telephone number is (571) 272-1068. The examiner can normally be reached on M-F 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on (571) 272-1078. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Melanie D. Bissett
Patent Examiner
Art Unit 1711

mdb